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PATENT

Attorney Reference Number 6541-61435-01
Application Number 10/017,629

Remarks:

Reconsideration of the application is respectfully requested in view of the foregoing amendments and following remarks. Claims 1, 4-18, 20 and 22-24 are pending in the application. No claims have been allowed. Claims 1, 6, 15, 18 and 20 are independent.

Clarification of Office Action Status or Request for Withdrawal of Final Office Action

The Office action summary indicates that this action is a Final Office action. However, Applicants respectfully note that the remarks in the body of the Action do not indicate that the Action is made final, as is customary. Applicants respectfully presume that the incorrect box on the summary was inadvertently checked by the Examiner. Clarification of this issue is requested.

Alternatively, if the Action is final, Applicants respectfully point out that a final rejection is improper. As stated in the MPEP:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

See MPEP 706.07(a) (emphasis added).

Applicants note that the Action introduces a new ground of rejection for at least claim 6 (over U.S. Pat. No. 5,600,704 to Ahlberg et al. (Ahlberg) in view of U.S. Pat. No. 5,644,624 to Caldwell (Caldwell)). Although claim 6 was amended by a previous response, these amendments corrected grammatical errors and did not necessitate the new ground of rejection. Additionally, neither Ahlberg nor Caldwell was cited in an IDS by Applicants. For at least these reasons, a final rejection is improper. The rejection should be withdrawn, and such action is respectfully requested.

Patentability of Claims 1, 4, 15-18, 20, and 22-24 over Humes and Caldwell under § 103

The Action rejects claims 1, 4, 15-18, 20, and 22-24 under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 6,721,577 to Humes (Humes) in view of Caldwell. This rejection is respectfully traversed. Applicants respectfully submit the claims in their present form are allowable over the cited art. To establish a *prima facie* case of obviousness, three basic

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criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Motivations to combine or modify references must come from the references themselves or be within the body of knowledge in the art. See MPEP § 2143.01. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142.

Claim 1

Claim 1, as amended, is directed in part to:

A wireless phone comprising . . .

a call queue function, the call queue function to enable the configuration of *an outgoing call queue stored in a server accessible over a network*, the outgoing call queue comprising an ordered list of entries to dial; and

a queue dial function which, when operated, *cooperates with the server* to result in a dialing of a next entry of the outgoing call queue and result in removing the next entry from the outgoing call queue. . . .

Applicants have amended the claim to point out “a call queue function [that] . . . enable[s] configuration of an outgoing call queue stored in a server accessible over a network . . . and a queue dial function which . . . cooperates with the server. . . .” Support for the amendment can be found in the original specification at, for example, page 6, lines 7-23.

Humes is silent as to a call function that enables configuration of an outgoing call queue stored in a server. Instead, Humes teaches that a “link list” is “stored within a telecommunications device, such as a mobile station.” See Abstract. Additionally, Humes is silent as to cooperating with a server to dial an entry from a call queue.

Caldwell does not overcome the shortcomings of Humes. For example, Caldwell likewise does not teach an outgoing call queue stored in a server accessible over a network. Instead, Caldwell teaches storing a telephone number for a call in a “parameters storage and queue 422,” which is contained in a control box 104 next to the user’s telephone 102. See, e.g., col. 3, lines 49-51 and col. 6, lines 2-5. Caldwell is also silent as to cooperating with a server in dialing an entry from an outgoing call queue. For at least these reasons, Humes and Caldwell fail to teach or suggest the claimed invention, singularly or in combination.

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Additionally, Humes teaches away from being modified to create the wireless phone of claim 1. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP 2141.02. The teachings of Humes are directed toward a method for contacting an individual who may be reached at one of several possible phone numbers. See, e.g., col. 1, lines 17-42. The solution proposed by Humes is to "sequentially originate[] outgoing call connections" according to a list of "linked directory numbers." See, e.g., col. 1, lines 19-23. The directory numbers are linked because the numbers are associated with a common party. Removing a directory number from the linked list of Humes would constitute disassociating that number with the other numbers in the list. This would arguably make the invention of Humes *less* useful, since a linked list would be destroyed upon use, even though the numbers on the list are presumably still associated with a common party. "If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP 2143.01. For at least these reasons, Humes teaches away from modifying its teachings to further include "a queue dial function which . . . result[s] in removing the next entry from the outgoing call queue" as taught by claim 1 of the application.

For similar reasons, Humes teaches away from being combined with Caldwell. Caldwell teaches a system and method where "[w]hen a call has been successfully completed the called number will be removed from a numbers queue. . . ." See Abstract. As explained above, such a modification would render Humes unsatisfactory for its intended purpose, and thus there is insufficient motivation to combine Humes with Caldwell.

For at least these reasons, one of ordinary skill would not combine Humes with Caldwell to obtain the invention of claim 1 of the application. The rejection should be withdrawn, and such action is respectfully requested.

Claim 4 depends from claim 1 and is allowable over Humes and Caldwell for at least the reasons stated above with respect to its parent claim. It is also patentable because of its unique combination of features. The rejection should be withdrawn, and such action is respectfully requested.

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Claim 15

As amended, claim 15 is directed, in part, to:

A method comprising:
dialing a first number of a call queue stored by a wireless communication device
in response to a first operation of a queue dial function;
removing the first number from the call queue *each time* the first number is
dialed; and
dialing a next number of the call queue in response to a second operation of the
queue dial function.

Applicants have amended the claim to point out “removing the first number from the call queue *each time the first number is dialed.*” Support for the amendment can be found in the original specification at, for example, page 2, lines 27-28.

As noted at page 2 of the Action, Humes does not teach “a queue dial function which, when operated, results in a dialing of a next entry of the outgoing call queue and . . . results in removing the next entry from the outgoing call queue.” Caldwell teaches that a “control processor 402 . . . deletes the *successful* call from the calls pending Queue.” See col. 7, lines 7-9 (emphasis added). In this context, a “successful call” is one that has “either reached the individual being called or [one where an] appropriate message has been provided.” See col. 1, lines 60-62. However, Caldwell does not teach that operating a queue dial function comprises “removing the first number from the call queue *each time* the first number is dialed.” Instead, Caldwell teaches:

When a call has been *successfully* completed the called number will be removed from a numbers queue within the system, and the system will record the time and date of the completion. Numbers remaining in the queue will be recalled *until successfully completed.*

See Abstract (emphasis added).

Caldwell teaches that a dialed number is not *always* removed from a queue, but is removed only if the call is “successful.” Humes and Caldwell do not, singularly or in combination, teach or suggest every limitation of claim 1. For at least these reasons, claim 1 is allowable over Humes and Caldwell. The rejection should be withdrawn, and such action is respectfully requested.

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Claims 16 and 17 depend from claim 15 and are allowable over Humes and Caldwell for at least the reasons stated above with respect to their parent claim. They are also patentable because of their unique combination of features. Claim 23 is a computer-readable medium claim that recites all features of claim 15 and is likewise patentable. The rejection should be withdrawn, and such action is respectfully requested.

Claim 18

Amended independent claim 18 recites, in part:

A method comprising:
dialing a first number of *a call queue stored by a server*, in response to an operation of a queue dial function in a wireless communication device *which accesses the server over a wireless network* . . .
removing the first number from the call queue. . . .

Applicants have amended the claim to point out “dialing a first number of a call queue *stored by a server*,” and “a wireless communication device *which accesses the server over a wireless network*.” Support for the amendment may be found in the original specification at, for example, page 6, lines 7-23.

For the reasons explained above with respect to claim 1, Humes and Caldwell, singularly or in combination, do not teach “a call queue stored in a server” or “access[ing] the server over a wireless network.” As explained above, Humes also teaches away from removing an entry from a call queue, as further recited in claim 18. For at least these reasons, claim 18 is allowable over Humes and Caldwell. The rejection should be withdrawn, and such action is respectfully requested.

Claim 24 is a computer-readable media claim incorporating all elements of claim 18. For at least this reason, claim 24 is allowable over Humes and Caldwell. The rejection should be withdrawn, and such action is respectfully requested.

Claim 20

Amended independent claim 20 recites, in part:

A wireless device, comprising:
a call queue, *stored on a server*, comprising an ordered set of entries; and
a queue dial function which, when operated, *accesses the server* and results in a dialing of a next entry in the call queue and results in removing the next entry from the

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call queue.

Applicants have amended claim 20 to point out "a call queue *stored on a server*" and "a queue function which . . . *accesses the server*." Support for the amendment may be found in the original specification at, for example, page 6, lines 7-23.

For the reasons explained above with respect to claim 1, Humes and Caldwell, singularly or in combination, do not teach "a call queue, stored on a server," and also do not teach "a queue dial function which . . . accesses the server." As explained above, Humes also teaches away from "removing the next entry from the call queue." For at least these reasons, claim 20 is allowable over Humes and Caldwell. The rejection should be withdrawn, and such action is respectfully requested.

Claim 22 depends from claim 20 and is allowable over Humes and Caldwell for at least the reasons stated above with respect to its parent claim. It is also patentable because of its unique combination of features. The rejection should be withdrawn, and such action is respectfully requested.

Patentability of Claims 6, 7 and 11-14 over Ahlberg and Caldwell under § 103

The Action rejects claims 6, 7 and 11-14 over Ahlberg in view of Caldwell. The language of the Action at page 4 suggests that the rejection is also based on U.S. Pat. No. 6,034,687 to Taylor et al. (Taylor). Although the Action states that the rejection is based on § 102(b), Applicants respectfully presume that the rejection is actually based on § 103, since two references are cited, and since the Action at page 4 concedes that Ahlberg does not disclose a queue management function. Regardless of whether the rejection is based on § 102 or § 103, and regardless of whether the cited references include Taylor, the rejection is respectfully traversed.

Claim 6

Claim 6 teaches, in part:

A communication system of a communication service provider, comprising . . .
a call queue . . . and
a queue management function to provide a next number to dial from the call queue in response to receipt of a queue dial request. . . .

Ahlberg and Caldwell, when "considered as a whole," do not "suggest the desirability

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and thus the obviousness of making the combination” of claim 6. See MPEP 2141. For example, Ahlberg describes a system that

... includes reprioritizing means, responsive to the communications link establishing means, for sorting the prioritized routing list of telephone numbers associated with the subscriber. In particular, the prioritized routing list is sorted such that the telephone from which the subscriber responded to the alert is assigned the highest priority and, accordingly, will be initially alerted by the communications link establishing means in response to the next telephone call placed to a telephone associated with the subscriber.

See col. 3, line 63 – col. 4, line 4.

In other words, the system of Ahlberg employs a prioritized list of phone numbers in attempting to contact a subscriber, and notes which phone number in a list of numbers was successfully used to do so. The next time a caller attempts to contact the subscriber, the system will first dial the number that was successfully used during the previous attempt. Thus it is necessary that the “successful” number be *retained* in the list.

In contrast, Caldwell teaches a system and method where “[w]hen a call has been successfully completed the called number will be removed from a numbers queue. . . .” See Abstract. More explicitly, it is a feature of Caldwell that numbers are *removed* from the numbers queue as *successful* calls are made. Thus when both references are considered in their entirety, Ahlberg teaches away from being combined with Caldwell. It would not have been obvious to one of ordinary skill in the art that the invention of claim 6 might be obtained by combining the teachings of Ahlberg and Caldwell. For at least these reasons, the rejection should be withdrawn, and such action is respectfully requested.

Claims 7 and 11-14 depend from claim 6 and are allowable for at least the reasons stated above with respect to their parent claim. Additionally, each is patentable because of the novel and nonobvious features of each claim. The rejection should be withdrawn, and such action is respectfully requested.

Patentability of Claim 5 over Humes, Caldwell and Taylor under § 103

Claim 5 stands rejected under 35 USC § 103(a) as allegedly obvious over Humes and Caldwell in view of U.S. Pat. No. 6,034,687 to Taylor et al. (Taylor). The language of the rejection (Action at 5) also suggests that the rejection is based in part on U.S. Pat. No. 6,363,411 to Dugan et al. (Dugan). In any case, this rejection is respectfully traversed.

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Claim 5 depends from claim 1 and is allowable for at least the reasons stated above with respect to claim 1. Taylor and Dugan do not overcome the deficiencies of Humes and Caldwell. Additionally, claim 5 is patentable because of its unique combination of features. The rejection should be withdrawn, and such action is respectfully requested.

Patentability of Claims 8 and 9 over Ahlberg, Caldwell and Widergren under § 103

Claims 8 and 9 stand rejected under 35 USC § 103(a) as allegedly obvious over Humes and Caldwell in view of U.S. Pat. No. 5,890,064 to Widergren et al. (Widergren). This rejection is respectfully traversed.

Claims 8 and 9 depend from claim 6 and are allowable for at least the reasons stated above with respect to claim 6. Widergren does not overcome the deficiencies of Ahlberg and Caldwell. Additionally, claims 8 and 9 are patentable because of their unique combinations of features. The rejection should be withdrawn, and such action is respectfully requested.

Patentability of Claim 10 over Ahlberg, Caldwell and Dugan under § 103

Claim 10 stands rejected under 35 USC § 103(a) as allegedly obvious over Ahlberg and Caldwell in view of Dugan. This rejection is respectfully traversed.

Claim 10 depends from claim 6 and is allowable for at least the reasons stated above with respect to claim 6. Dugan does not overcome the deficiencies of Ahlberg and Caldwell. Additionally, claim 10 is patentable because of its unique combination of features. The rejection should be withdrawn, and such action is respectfully requested.

Request For Interview

If any issues remain, the Examiner is formally requested to contact the undersigned attorney prior to issuance of the next Office Action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution. Applicants submit the foregoing formal Amendment so that the Examiner may fully evaluate Applicants' position, thereby enabling the interview to be more focused.

This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

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Conclusion

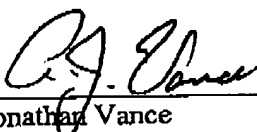
The claims in their present form should now be allowable. Such action is respectfully requested.

Respectfully submitted,

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